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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91209647
Party	Defendant Middleburg Real Estate, LLC
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Date	07/08/2013
Attachments	REPLY_Emergency_Motion_Opp_No_91209647.pdf(17913 bytes) Exhibit_A-REPLY_Declaration_Emergency_Motion_Opp_No_91209647.pdf(164 22 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re: Application Serial No.: 85/629,450
For the Mark: ATOKA PROPERTIES

Jorge J. Carnicero,

Opposer,

v.

Opposition No. 91/209647

Middleburg Real Estate, LLC

Applicant.

**REPLY TO OPPOSER'S OPPOSITION TO EMERGENCY MOTION FOR
PROTECTIVE ORDER AND TO STAY DISCOVERY**

Applicant, Middleburg Real Estate, LLC ("Applicant"), hereby replies to Opposer's Opposition to the Emergency Motion for Protective Order and to Stay Discovery.

Opposer's accusations of fraud, misstatements or lack of candor (all not true) cannot distract the Board from the following:

1) The issues in the DC Case and the Opposition are so closely linked that a stay is more than appropriate. Opposer's misuse of discovery in the Opposition to explore issues and parties from the DC Case confirms the link;

2) Settlement discussions *are* ongoing between the parties for both the DC Case and the Opposition, which further justifies a stay;

3) Opposer has no good faith basis to subpoena the deposition of Natalia Pejacsevich; and

4) Discovery should be stayed, including the deposition of Ms. Pejacsevich or any other witnesses.

1. The Issues In The DC Case And The Opposition Are So Closely Linked That A Stay Is Appropriate.

Opposer in filing the DC Case asserted that the DC Court has jurisdiction to determine rights in the Atoka Properties and Atoka farm and Atoka trademarks. Applicant's filing of a procedural motion to dismiss disputing that jurisdiction changes nothing. Opposer has opposed the motion, again asserting that jurisdiction in the DC Case is proper. Unless and until the DC Court decides it lacks jurisdiction, there are unquestionably related issues pending in the DC court and the TTAB.

Opposer is using the Opposition to seek discovery of parties and issues involved only in the DC Case. Ms. Pejacsevich is not a party in the Opposition nor involved in the business of the Applicant, but is a party in the DC Case. The document requests served by Opposer do not relate to the mark at issue in the Opposition, but relate to issues in the DC Case.

The linked parties, issues, discovery tactics and settlement discussions make it clear that the DC Case and the Opposition involve common issues and parties. Based on longstanding policy, the TTAB should suspend the Opposition until the DC Case is resolved, or until the DC court decides it lacks jurisdiction to rule on the trademark issues.

2. The Parties Are Actively Engaging In Settlement Discussions To Resolve The Opposition and The DC Case

Opposer's counsel denies that that parties discussing settlement, stating:

"the claim that there are ongoing settlement negotiations (active or otherwise) between the parties to this opposition is simply false"

Not true. Attached is the Declaration of Andrew Cook who is counsel to certain defendants in the DC Case (Exhibit A). Mr. Cook has conferred with Ms. Baum counsel for the other Opposer CCT several times over the last few weeks. Ms. Baum has acted as a "mediator" gathering comments from Opposer through Michelle Rosati, a partner of Ms. Middlebrook, to broker a settlement of the trademark dispute between Applicant, the individuals involved in the

DC Case and Opposer Jorge Carnicero. Ms. Rosati is copied by Ms. Middlebrook on numerous emails regarding this dispute including those relied upon by Opposer and no doubt is aware of the discovery sought by Opposer and the settlement negotiations. Ms. Baum promised a draft of the agreement that would be acceptable to Opposer to Mr. Cook by Wednesday July 3.

Ms. Middlebrook's Declaration says only that "there are no ongoing settlement discussions between myself on behalf of opposer and counsel for Applicant" Middlebrook Dec. Par. 2 (emphasis added). Surely *who* is conducting the discussions is not important – it is clear the parties have been discussing settlement.

3) Opposer Has No Good Faith Basis To Subpoena The Deposition Of Natalia Pejacsevich

Opposer struggles to justify issuing a subpoena to Ms Pejacsevich noting that she is a defendant in the DC Case. See Opposer's Response, FN. 1. She is and has nothing to do with the Opposition. Opposer's counsel asks "if there were such active settlement discussions, the Opposer would not be setting depositions". See Opposer's Response Pg. 2. Opposer rightly concedes that it would be not make sense to bull ahead with such depositions.

4) Discovery Should Be Stayed, Including The Deposition Of Ms. Pejacsevich.

Because good cause for a stay has been shown, and no reason of any kind has been given why Opposer needs discovery immediately, particularly as settlement is ongoing and even Opposer admits it would make no sense to proceed in view of settlement discussions, the Board should grant the Protective Order and stay all discovery in this Opposition.

III. CONCLUSION

WHEREFORE, Applicant respectfully requests that the Board schedule an emergency telephonic conference as soon as possible to discuss the emergency motion, suspend the

proceedings including all discovery pending a decision on the Motion to Stay and order that Opposer immediately withdraw its subpoena for Natalia Pejacsevich's July 11, 2013 deposition or any other subpoenas or notices of deposition that it may have issued.

Respectfully submitted,

K&L Gates, LLP
Counsel for Applicant

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Date: July 3, 2013

CERTIFICATE OF FILING, MAILING AND SERVICE

I hereby certify that on July 3, 2013, the foregoing APPLICANT'S REPLY TO
OPPOSER'S EMERGENCY MOTION FOR PROTECTIVE ORDER AND TO STAY
DISCOVERY is being served by mailing a copy thereof by first-class mail addressed to:

Theresa W. Middlebrook
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and by email to: theresa.middlebrook@hklaw.com.

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Exhibit A

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For the Mark: ATOKA PROPERTIES

Jorge J. Carnicero,

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Opposition No. 91/209647

Middleburg Real Estate, LLC

Applicant.

DECLARATION OF ANDREW N. COOK

1. I am a partner at K&L Gates LLP and provide this declaration in support of Applicant's Emergency Motion for Protective Order.
2. I am counsel for defendants Natalia Pejacsevich and Peter Pejacsevich in the Superior Court litigation *Jorge J. Carnicero vs. Jacqueline C. Duchange, Chevy Chase Trust Company, Natalia Pejacsevich, Peter Pejacsevich and Inter-Properties, Inc., Trans- American Aeronautical Corporation*, Case No. 2013-001400 B (the "DC Case").
3. As counsel in the DC Case, I have also been involved in negotiating a potential settlement of the common trademark issues in the Oppositions filed by Jorge Carnicero and by Chevy Chase Trust Company (CCT), (the "Oppositions").
4. I have conferred with Ms. Baum at Pillsbury Winthrop, counsel for CCT, several times over the last weeks.

5. Ms. Baum agreed to facilitate settlement by directly communicating with counsel for Jorge Carnicero, Ms. Michelle Rosati at Holland and Knight, such that an agreement would be reached between all parties including Jorge Carnicero. Ms. Baum prepared and forwarded a draft settlement agreement to me. Ms. Baum and I discussed the settlement agreement terms in late May of 2013.
6. Pursuant to my understanding, Ms. Baum drafted the settlement agreement after engaging in discussions with Ms. Rosati and myself. After reviewing the draft agreement, I forwarded my comments and revisions to Ms. Baum on June 28, 2013.
7. On June 17, 2013, in the DC Case, with the specific consent of all the parties, including Jorge Carnicero, CCT filed a Consent Motion with the Superior Court to continue the initial conference in the case for 90 days to allow settlement discussions to proceed unimpeded by the additional cost of litigation activities and expenses. The Consent Motion stated that the avoidance of litigation activities and expenses during the next 90 days would enhance their respective abilities to resolve the litigation amicably. The Superior Court granted the Consent Motion.
8. The agreement I received from Ms. Baum and returned to her would settle the trademark dispute in the DC Case and the Oppositions, and would bind the parties including Jorge Carnicero.
9. I have conferred with Ms. Baum or her co-counsel on numerous occasions in an effort to facilitate settlement discussions including reaching out to Ms. Baum or her co-counsel on June 18, June 26, June 27, and June 28. In my conversation

with Ms. Baum on June 28, 2013, she promised to forward to me a revised draft of the settlement agreement by July 1, 2013 which she hoped would be in line with her discussions with me and Ms. Rosati, counsel for Jorge Carnicero. When I spoke to Ms. Baum on July 1, 2013 after not having received the revised agreement, she stated that she would have a revised agreement to me by July 3 or soon thereafter.

I declare under penalty of perjury that the foregoing is true and correct.

Date: July 8, 2013

/s/ Andrew N. Cook
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